

## Dispute Resolution Service

DRS 12280

Decision of Independent Expert

MVP Global LLC

and

Adam Danyal

### 1. Parties

Complainant : MVP Global LLC  
2nd Floor, 233 High Holborn  
London  
WC1V 7DN  
United Kingdom

Respondent : Mr Adam Danyal  
Superstar London Limited  
International House  
124 Cromwell Road  
Kensington  
London  
SW7 4ET  
United Kingdom

### 2. Domain Name

wherelondon.co.uk (the "Domain Name")

### **3. Procedural Background**

On 19<sup>th</sup> December 2012 the Complaint was lodged with Nominet UK Limited (“Nominet”) and on 20<sup>th</sup> December 2012 it was validated. Also on 20<sup>th</sup> December 2012 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising it to log into its account to view the details of the Complaint and giving it 15 working days within which to lodge a Response on or before 15<sup>th</sup> January 2013. On 11<sup>th</sup> January 2013 Nominet sent a Response reminder to the Respondent.

The Respondent responded on 15<sup>th</sup> January 2013. On 16<sup>th</sup> January 2013 Nominet informed the Complainant that the Response was available to be viewed via the Complainant’s online services account and inviting it to Reply to the Response on or before 23<sup>rd</sup> January 2013. On 23<sup>rd</sup> January 2013 Nominet informed the Respondent that the Reply was available to be viewed via the Respondent’s online services account. Mediation documents were generated for the Complaint and mediation commenced on 28<sup>th</sup> January 2013. Mediation was unsuccessful and concluded on 11<sup>th</sup> February 2013.

On 15<sup>th</sup> February 2013 the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (the “Policy”).

On 19<sup>th</sup> February 2013 Mr. Niall Lawless (the “Expert”) was selected and on 22<sup>nd</sup> February 2013 was formally appointed to act as Expert in this dispute, having confirmed that he knew of no reason why he could not properly accept the appointment and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in-to question his impartiality and -/- or independence. He is required to give his Decision by 15<sup>th</sup> March 2013.

### **4. Outstanding Formal -/- Procedural Issues**

There are no outstanding formal or procedural issues.

### **5. Factual background**

The Complainant, MVP Global LLC is a publisher of visitor and tourist magazines covering a wide range of destinations in the America’s, Asia and Europe. It uses the name “WHERE” and links that to a geographic location such as “London” to provide a local guide to entertainment and events.

Printed "WHERE London" magazines are distributed using a variety of means such as through London hotels, private member clubs, embassies, tourist visitor centres and conference centres across London and also provided over the internet.

The Complainant is the registered proprietor of a variety of UK registered trademarks containing or consisting of the term "WHERE" in a range of classes.

On 14<sup>th</sup> January 2012 the Respondent registered the Domain Name and had been using it to send out daily e-mails providing information about entertainment in London. The Domain Name is currently resolving to [www.sedo.co.uk](http://www.sedo.co.uk), where it is advertised for sale on behalf of the Respondent for \$10,000, without content, through Sedo's Domain Marketplace.

The Complainant seeks transfer of the Domain Name.

## **6. The Parties' contentions**

### The Complainant

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under Nominet's Dispute Resolution Service Policy (the "Policy") because:-

- the Respondent's use of the Domain Name has caused and continues to cause confusion amongst customers, advertisers and industry partners in the UK and this confusion is likely to result in damage to the Complainant's reputation.
- the Respondent is currently offering to sell the Domain Name for US \$10,000 and its intentions are to gain financially because of the Complainant's reputation and trademarks.

### The Respondent

The Respondent says that the Domain Name controlled by it is not an Abusive Registration under Nominet's Dispute Resolution Service Policy (the "Policy") because:-

- there are hundreds of active businesses and names that start with "WHERE" and the term "WHERE" is an ambiguous term which does not give protection for any following keywords.
- the term "WHERE London" is not a registered trademark in the UK.

- whereas the Respondent registered the Domain Name on 14<sup>th</sup> January 2012, the Complainant only applied for the trademark for "WHERE London" on 13<sup>th</sup> December 2012. It has done this in a desperate attempt to snatch the Domain Name.
- the domain is not currently active; therefore, this dispute had no point.

## 7. Discussions and Findings

### 7.1 General

Nominet's Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities that:-

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Complainant is required to prove to the Expert that the Complainant has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

### 7.2 Complainant's Rights

The Complainant is the registered proprietor of UK registered trademarks, numbers 1447257 and 2607017 in the term "WHERE" in a range of classes.

The Respondent says that the Complainant has only applied for the trademark for "WHERE London" on 13<sup>th</sup> December 2012 and the term "WHERE London" is not a registered trademark in the UK.

However, in addition to its registered trademarks, the Complainant has demonstrated that it has published monthly magazines using the name “WHERE London” since January 2007. Archived copies of the Complainant’s “WHERE London” magazine can be located via the URL :-

- [www.wheretraveler.com/classic/intl/uk/london/where\\_archive](http://www.wheretraveler.com/classic/intl/uk/london/where_archive).

The Complainant’s also asserts that it has continually used the term “WHERE London” since 1975. In terms of distribution the printed magazine currently has an average monthly circulation of 75,000 copies and about 345,000 people each month read the “WHERE London” magazine (Source: Mediamark Research Inc.).

The Respondent does not dispute that the Complainant has published its “WHERE London” magazine in traditional print format or via the internet for many years; nor does it challenge the substantial “WHERE London” magazine distribution figures.

The Complainant does have Rights both in WHERE because of the trademark registrations and in “WHERE London” because of its long term trading under that name which is not disputed by the Respondent.

Because of the above, I decide that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name.

### 7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration, but it does not state under which part of Nominet’s Policy.

Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

“A non-exhaustive list of factors which may evidence that the Domain Name is an Abusive Registration is as follows :-

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(A). for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

3(a)(ii). Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;”

Using Domain Name to Confuse

The Complainant says that the Respondent was using the Domain Name to send out daily e-mails providing information about entertainment in London, alerting recipients of current events and special deals. The Complainant says that these activities are identical and confusingly similar to its activities.

This would demonstrate that the Domain Name is an Abusive Registration under Nominet’s DRS Policy section 3(a)(ii).

The Respondent has not responded to the above and offered no evidence.

The Complainant has provided copies of e-mails sent by the Respondent on 10<sup>th</sup>, 11<sup>th</sup>, 12<sup>th</sup>, 13<sup>th</sup>, 14<sup>th</sup>, 17<sup>th</sup>, 18<sup>th</sup> and 19<sup>th</sup> December 2012 to Mrs. Rosemary Cardas, *“delivering her one unbeatable deal on the best things to do, see, eat, and buy in London”*.

By way of example of actual confusion, the Complainant provides a copy of a 13<sup>th</sup> December 2012 e-mail from Ms. Lanier Brannan, the Managing Director of LBProductions of London Ltd.

Ms. Brannan refers to the Respondent’s e-mails as confusing and misleading.

She says *“For a month or two before I learned they weren’t from you guys, I was opening them, thinking that they were from an organisation that I knew and trusted. I imagine that a lot of people who receive them are opening them rather than reporting them as SPAM because they think the*

*same thing. I haven't bought anything from them, but if I had, I would have done so with full confidence that the offer was from you guys – not some group I don't know. I think it's a problem."*

Because of the Respondents e-mails, their content and the evidence provided by Ms. Brannan, I decide that the Domain Name is being used in a way which has confused and will confuse people or businesses which is evidence under Paragraph 3(a)(ii) of the Policy that in the control of the Respondent the Domain Name is an Abusive Registration.

It is irrelevant that the Domain Name is not currently active.

#### Selling the Domain Name for Financial Gain

The Complainant also says that the Respondent is currently offering to sell the Domain Name for US \$10,000 and its intentions are to gain financially because of the Complainant's reputation and trademarks.

Evidence of Abusive Registration are circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

Whereas initially the Respondent used the Domain Name to send out daily e-mails providing information about entertainment in London; currently the Domain Name is resolving to [www.sedo.co.uk](http://www.sedo.co.uk), where it is advertised for sale on behalf of the Respondent for \$10,000, without content, through Sedo's Domain Marketplace. If the Respondent sells the Domain Name for ten thousand dollars, that would be considerably in excess of its out-of-pocket costs directly associated with acquiring or using the Domain Name.

However, the test for Abusive Registration is not that the Domain Name is sold to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs, but that it was acquired for that purpose.

Because of the way in which it was first used, it is clear to me that the Domain Name was registered not initially to be offered for sale, but among other things for distributing e-mails using a highly visible branding “wherelondon.co.uk” and offering recipients an “*unbeatable deal on the best things to do, see, eat, and buy in London*”. Because of that I decide that the Domain Name in the hands of the Respondent is not abusive in accordance with paragraph 3(a)(i)(A) of the Policy.

#### 7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and that the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

### 8. Decision

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.

**Niall Lawless, Nominet Expert**

**6<sup>th</sup> March 2013**